

11-28-05
DHSRAN: Attorney Review
11/30/05

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAZEN HANNA and PETER YORK

Appeal No. 2005-2464 ✓
Application No. 10/095,715

ON BRIEF

Before CAROFF, HANLON, and POTEATE, Administrative Patent Judges.CAROFF, Administrative Patent Judge.DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 220-221 and 254-258.¹ All of the other pending claims in the involved reissue application have been indicated by the examiner as being allowable.

All of the appealed claims depend from independent claim 16 which is directed to a "method for the formation of a particulate product." Claim 220, reproduced below, is representative of the dependent claims on appeal:

¹The rejection appealed from was not designated by the examiner as being final. Nevertheless, since the subject claims have been at least "twice rejected," we have authority to consider the present appeal under 35 U.S.C. § 134(a).

220. Method according to claim 16 further comprising placing said particulate product in an inhaler.

No prior art references are relied upon by the examiner.

Claims 220-221 and 254-258 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to further limit the claim from which they depend.²

The same claims alternatively stand rejected under 35 U.S.C. § 101 as improperly subsuming more than one category of invention.

Additionally, the subject claims stand rejected under 35 U.S.C. § 251 as improperly enlarging the scope of the original patent claims beyond the two-year grace period provided by the statute for broadening reissue applications.

Based upon the record before us, we are compelled to reverse each of the rejections at issue essentially for the reasons set forth in the appellants' brief and reply brief.

Specifically, with regard to the rejection under 35 U.S.C. § 112, we agree with the appellants that the subject dependent claims do, in fact, further limit the independent claim from which they all depend.

² We note that the statutory provision concerning dependent claims is more precisely spelled out in the fourth paragraph of 35 U.S.C. § 112.

According to the examiner, the recited steps in the appealed claims which relate to a use of a particulate product cannot be considered part of a method which has, as its recited purpose, the "formation of a particulate product." We disagree. "Formation" is merely an expression of one expected or intended outcome of the claimed process and does not, in any way, preclude additional limiting steps in the process which may provide additional results or benefits. For example, in this case it is clear that the method of claim 220 includes the additional step of placing the particulate product in an inhaler for the purpose of dispensing the product.

With regard to the rejection under 35 U.S.C. § 101, the examiner opines that the rejected claims are improperly drawn to more than one statutory category of invention, i.e., a method of making, as well as a method of using, a particular product. Again, we most emphatically disagree. Conceptually, the claimed invention should be viewed as a process for making a product, then using the resulting product in a particular application. As noted in appellants' reply brief, § 101 of the patent statute does not define "making" and "using" as two distinct categories of invention. We see no reason why a "process," within the scope of the statute, cannot include both "making" steps and "using" steps. The examiner cites no recognized authority which holds otherwise.

As to the rejection under 35 U.S.C. § 251, there is simply no basis for the examiner's conclusion that the rejected claims broaden the scope of the original patent

claims. The rejected claims add positive manipulative steps to original method claim 16 and , thereby, narrow its scope.

For all of the foregoing reasons, the decision of the examiner is reversed.

REVERSED

MARC L. CAROFF/
Administrative Patent Judge

ADRIENE LEPIANE HANLON
Administrative Patent Judge

LINDA R. POTEATE
Administrative Patent Judge

)
)
)
)
)
)
)
BOARD OF PATENT
APPEALS
AND
INTERFERENCES

MLC/lbg

Appeal No. 2005-2464
Application No. 10/095,715

Page 5

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA, VA 22304



Neifeld IP Law, P.C.
Crystal Plaza 1, Suite 1001
2001 Jefferson Davis Highway
Arlington, VA 22202

THIS IS A FILING RECEIPT

Status Check 3/18/05

Neifeld IP Law Docket No.: INHA0013ICO/US

Application Serial No.: 10/095,715

INHA0013I/US

Filed: March 8, 2002

Inventor: HANNA, et al

Title: METHOD AND APPARATUS FOR THE
FORMATION OF PARTICLES

The following has been received in the U.S. Patent Office on the date stamped hereon:

TRANSMITTAL LETTER (1 page IN DUPLICATE)
37 CFR 41.4 REPLY BRIEF (4 pages)

Printed: March 26, 2004 (3:19 PM)
Y:\Clients\Nektar (Formerly Inhale Therapeutics)\INHA0013IUS\Drafts\FR_050114.wpd

RB_INHA0013ICOUS_050118.pdf

NEIFELD IP LAW, P.C.
2001 Jefferson Davis Highway
Suite 1001
Arlington, VA 22202

Tel: 703-415-0012
Fax: 703-415-0013
Email: meifeld@Neifeld.com
Web: www.Neifeld.com

TRANSMITTAL LETTER AND AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

RE: Attorney Docket No.: INHA0013ICO/US
Application Serial No.: 10/095,715
Filed: 3/8/02
Title: Method and Apparatus for the Formation of Particles
Inventor: Hanna, et al
Group Art Unit: 1732
Examiner: Mary Theisen

SIR:

Attached hereto for filing are the following papers:

37 CFR 41.41 REPLY BRIEF (4 pages)

Our check in the amount of \$0 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.

31518
PATENT TRADEMARK OFFICE

1/18/2005
Date


Robert G. Crockett
Registration No. 42,448
Richard A. Neifeld, Ph.D.
Registration No. 35,299

Printed: January 18, 2005 (2:32pm)
Y:\Clients\Nektar (Formerly Inhale
Therapeutics)\INHA0013IUS\Drafts\Transmittal_050114.wpd

NEIFELD IP LAW, P.C.
2001 Jefferson Davis Highway
Suite 1001
Arlington, VA 22202

Tel: 703-415-0012
Fax: 703-415-0013
Email: rneifeld@Neifeld.com
Web: www.Neifeld.com

TRANSMITTAL LETTER AND AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

RE: Attorney Docket No.: INHA0013ICO/US
Application Serial No.: 10/095,715
Filed: 3/8/02
Title: Method and Apparatus for the Formation of Particles
Inventor: Hanna, et al
Group Art Unit: 1732
Examiner: Mary Theisen

SIR:

Attached hereto for filing are the following papers:

37 CFR 41.41 REPLY BRIEF (4 pages)

Our check in the amount of \$0 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.

31518
PATENT TRADEMARK OFFICE

1/18/2005
Date


Robert G. Crockett
Registration No. 42,448
Richard A. Neifeld, Ph.D.
Registration No. 35,299

Printed: January 18, 2005 (2:32pm)
Y:\Clients\Nektar (Formerly Inhale
Therapeutics)\INHA0013IUS\Drafts\Transmittal_050114.wpd

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: HANNA ET AL.

APPLICATION NUMBER: 10/095,715

CONFIRMATION NO: 4957

GROUP: 1732

EXAMINER: MARY THEISEN

FILED: March 8,2002

FOR: METHOD AND APPARATUS FOR THE FORMATION OF PARTICLES

37 CFR 41.41 REPLY BRIEF

BOX STOP APPEAL BRIEF - PATENTS
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Sir:

In reply to the Examiner's Answer mailed November 16, 2004, the applicants submit this reply brief pursuant to 37 CFR 41.41. The applicants submit no new amendments, affidavits, or other evidence.

I. **The Rejections of Claims 220, 221 and 254-258 Under 35 USC 112, Second Paragraph**

In the Examiner's Answer mailed November 16, 2004, the examiner asserts at page 4 lines 8-14 that:

It is Appellant's assertion that because claims 220, 221 and 254-258 contain additional steps they further limit the subject matter of claim 16. The claims in question do contain additional steps but they do not further limit the subject matter of claim 16. Claim 16 is directed to a process of making particles. Filling an inhaler or inhaling (the subject matter of claims 220, 221 and 254-258) is not a step in the formation of particles. Since this subject matter is not a step in the formation of particles it cannot further limit the subject matter of claim 16.

[Examiner's Answer at page 4 lines 8-14.]

In reply, the applicants respectfully point out that the examiner provides no reasoning supporting these assertions. The appeal brief explains why these rejections are improper.

II. **The Rejections of Claims 220, 221 and 254-258 Under 35 USC 101**

In the Examiner's Answer mailed November 16, 2004, the examiner asserts at page 4 line 18 to page 5 line 6 that:

It was not the Examiner's intent to suggest that these claims are product by process claims. The claims are clearly not. They are method claims. The product by process section of the MPEP was cited to show that product by process claims are the exception to the rule that claims may contain only one class of invention. Since the present claims are not product by process claims they do not fall within the exception to only one class of invention in a claim.

Appellants argue that the claims do not define more than one class of invention because all of the claims are method claims. Claim 16 is a method of making. Claims 220, 221 and 254-258 are methods of use. A method of making

and a method of use are different categories of invention. [Examiner's Answer at page 4 line 18 to page 5 line 6.]

In reply, the applicants respectfully point out that 35 USC 101 makes no distinction between a method of making and a method of using.

III. The Rejections of Claims 220, 221 and 254-258 under 35 USC 251

In the Examiner's Answer mailed November 16, 2004, the examiner asserts at page 5 lines 12-17 that:

Appellants contend that the claims are not broader than the original claims because they contain an additional step. The original claims were directed to a method and apparatus of making particles. Claims 220, 221 and 254-258 are directed to using the particles. These claims are of a different scope than the original claims. The change in scope broadens the claims. For the above reasons, it is believed that the rejections should be sustained. [Examiner's Answer at page 5 lines 12-17.]

In reply, the applicants respectfully point out that dependent claims include all of the limitations of their base claims.

Respectably Submitted,

1/18/2005

Date

Robert G. Crockett

Robert G. Crockett

Registration No. 42,448

RGC

Printed: January 18, 2005 (2:30pm)

**Y:\Clients\Nektar (Formerly Inhale
Therapeutics)\INHA0013IUS\Drafts\ReplyBrief050118.wpd**

ATTACHMENT 15

Rick Neifeld

From: JLPImen@aol.com
Sent: Tuesday, May 08, 2007 4:06 PM
To: Rick Neifeld; krichardson@anitox.com
Subject: Re: LipasePatentIssue_ANIT0018U-USA_5-8-2007

Hi Rick:
I think you misinterpreted my comments, anyway:
I am sending the claims as word files.
Take care

Julio

Julio L. Pimentel Ph.D.
G.V.D. Corp.
3206 Windgate Dr
Buford, GA 30519
770-598-5518
770-945-9762 fax

See what's free at AOL.com.

Claims

1. (currently amended) A method for inhibiting lipase activity in a mammal, said method comprising the step of: administering to the mammal an avian antibody that decreases activity of lipase relative to a control, wherein said control does not receive said avian antibody.
- 2-4 (cancelled)
- 5-6 (withdrawn)
- 7 (cancelled)
- 8 (currently amended) The method of claim 1, wherein prior to the step of administering to the mammal said avian antibody, said avian antibody is produced in avian eggs.
- 9-10 (withdrawn)
- 11 (cancelled)
- 12-13 (withdrawn)
- 14 (previously amended) The method of claim 1, wherein prior to the step of oral administering said avian antibody, said avian antibody is first freeze dried or spray dried.
- 15-16 (withdrawn)
- 17 (cancelled)
- 18 (previously amended) The method of claim 1, wherein said avian antibody is fed in powder form.
- 19-22 (cancelled)
- 23-24 (withdrawn)
- 25-30 (cancelled)

31 (previously amended) The method of claim 1, wherein said avian antibody is fed in liquid form.

32-46 (cancelled)

47 (currently amended) A method of inhibiting absorption of fat in mammals by inhibiting lipase activity, said method comprising the step of:
administering anti-lipase avian antibody that decreases activity of lipase relative to a control.

48-50 (withdrawn)

51 (currently amended) The method of claim 47, wherein said step of orally administering anti-lipase avian antibody comprises orally administering said anti-lipase avian antibody in combination with the mammal's feed or food.

52-54 (cancelled)